



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/124,374 09/20/93 FRIESE

A J&J1500

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REICHLER EXAMINER

ART UNIT	PAPER NUMBER
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3308

28

DATE MAILED: 03/24/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 9-20-93 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-12 and 14-23 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 13 ^{has} been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-12 and 14-23 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by its Serial Number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed alterations have been made to the oath or declaration (see 37 C.F.R. §§ 1.52(c) and 1.57).

See the residence line of the first inventor and the citizenship line of the second inventor.

The drawings are objected to because in Figure 10, the location of the rib 17 with respect to orifice 30 and sliding plates 24, ^{is inconsistent} compare to Figure 7, i.e. the rib 17 is spaced radially inward from the orifice of the performing press in the closed state of its press dies. Correction is required.

The amendment filed February 1, 1993 and August 16, 1993 is objected to under 35 U.S.C. § 132 because it introduces new matter into the specification. 35 U.S.C. § 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Page 1, line 36, page 5, lines 8-9, page 3, lines 20-21 and page 7, line 26 of the February 1, 1993 amendment and page 4, lines 13, 19 and 21 of the August 16, 1993 amendment.

On page 1, line 36 and page 5, lines 8-9, as best understood, see claim 1, the absorbent portion is the wound

blank. Therefore, there is no support for the wound blank consisting of fibers with a weight which can have a specific absorption capacity and rate of absorption. There is only support for the tampon having such. The amendments on pages 3 and 7 are not supported as there is no support for there being more than one embodiment. This also applies to page 4, lines 19 and 21. With respect to page 4, line 13, Figure 2 does not show a preform, but a tampon.

Applicant is required to cancel the new matter in the response to this Office action.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e. failing to provide an enabling disclosure and as failing to provide an adequate written description of the invention.

1) Figures 1, 2 and 4 were described in the originally filed specification as a longitudinal section, a cross-section and an enlarged cross-section of the tampon. However, Figures 2 and 4

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are inconsistent, i.e. one shows open grooves and one shows enclosed grooves. Applicant has amended the specification to indicate there are two embodiments of the tampon which, as discussed supra, is not supported by the original specification. Therefore, the specification fails to adequately teach how to make and/or use the invention because it is unclear whether the tampon as made includes open grooves or enclosed grooves.

2) The disclosure should be commensurate in scope with claim 15.

Claims 1-12 and 14-23 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 1-12, 14-19 and 21-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, line 8, "core" should be --portion--
to be consistent. In regard to claim 2, lines 1-3 are redundant,
i.e. on line 2, "blank comprises a" should be deleted and on line
3, "consisting" should be --consists--. In regard to claim 5,
line 3, after ",", --and-- should be inserted. In regard to
claims 6 and 22, the language of lines 13-14 of claim 6 and the
language of claim 22 appears to be inconsistent, i.e. do grooves
separate the ribs or not? In regard to claim 10, line 2, "of the

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press cutters" should be --presscutter-- to be consistent. In regard to claim 11, line 2, "faces" should be --face-- to be consistent. In regard to claim 12, see remarks with respect to claim 10 which also apply here. In regard to claim 15, lines 3-5 are indefinite. In regard to claim 16, are the orifices in this claim and those in claim 9 one and the same.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1, 20 and 23 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as

obvious over Rabell. See col. 1, line 44 and col. 2, lines 1-16. The tampon is or obviously is identical to the tampon claimed in product-by-process claims 1 and 20 and claim 23. See MPEP 706.03(e).

Claims 6-7 are rejected under 35 U.S.C. § 103 as being unpatentable over Rabell in view of Bailey. The method of making the Rabell device includes all the claimed steps except for winding up a length of tape shaped non-woven. However, Bailey teaches that a spirally wound blank or a folded blank are equivalents for use in forming a compressed tampon. To make the folded blank of Rabell a spiral blank instead would be obvious to one of ordinary skill in the art in view of the equivalence as taught by Bailey.

The remainder of the claims define over the art.

In regard to Applicant's remarks on pages 6-13, such remarks, except for the remarks specifically addressed below, are drawn to objections and/or rejections which have not been repeated. With regard to Applicant's remarks in the first paragraph of page 9, such remarks are deemed non-persuasive in that it is unclear what "an absorbent portion" has been added refers to. Applicant could overcome this objection by pointing out the absorbent portion is a tampon according to the invention consisting of a needle non-woven composed of 100% of rayon fibers as set forth on the bottom of page 4 and in claim 2. With regard

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to Applicant's remarks on page 9, second paragraph, Applicant's remarks are deemed non-persuasive because original figures 2 and 4 and the descriptions thereof and of the tampon therein did not disclose that there was a first and second embodiment. In regard to Applicant's remarks on page 12 with respect to Rabell, such arguments are deemed non-persuasive in light of MPEP 706.03(e), product-by-process claims 1 and 20 and no structural limitations precluding hollowness, i.e. a core or ribs can be compressed and still hollow.

Any inquiry concerning this communication should be directed to K. Reichle at telephone number (703) 308-2617.

K. Reichle/dh
March 08, 1994
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K.M. Reichle
KARIN REICHLE
PATENT EXAMINER
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